

REMARKS

Claims 1-51 are all the claims pending in the application. Applicants note that claims 26-51 have been withdrawn from consideration by the Examiner as being drawn to a non-elected invention.

I. Election/Restriction

Initially, in item 1 on page 2 of the Office Action, the Examiner indicates that Applicants did not traverse the restriction requirement of claims 26-30. Applicants respectfully disagree and point the Examiner's attention to the arguments presented in the responses filed on June 7, 2005 and November 21, 2005, as well as the comments below.

Regarding claims 26-30, in item 3 on page 2 of the Office Action, the Examiner has indicated that claims 26 and 27 are related as combination and subcombination. Applicants note, however, that claim 27 depends from claim 26 and recites the following: "The switching power supply module according to claim 26, wherein the switching power supply module is a DC/DC converter."

Accordingly, as claim 27 depends from claim 26, and merely defines the type of switching power supply module, Applicants respectfully submit that claims 26 and 27 are in no way whatsoever related as combination/subcombination. That is, as claim 27 depends from claim 26, and therefore incorporates all of the limitations of claim 26, it is clear that these claims cannot be restricted from one another based on combination/subcombination.

If the Examiner maintains the position that claims 26 and 27 are to be restricted as combination/subcombination, Applicants kindly request that the Examiner provide an explanation based on the criteria for this type of restriction as set forth in MPEP 806.05(c).

Further, regarding claims 28-30, Applicants note that claims 28 and 29 are each independent claims, and claim 30 depends from claim 28. The Examiner indicates that claims 28-30 are related as combination and subcombination, but has not identified which claim(s) allegedly correspond to the combination and which claim(s) allegedly correspond to the subcombination. Based on the criteria set forth in MPEP 806.05(c), it is respectfully submitted that claims 28-30 cannot be restricted based on combination/subcombination.

In this regard, Applicants note that based upon a review of the claims and the Examiner's comments in the Office Action, Applicants believe that the Examiner has intended to indicate that claims 26, 28 and 29 are combination claims, and that claim 1 is a subcombination claim. However, as noted by the Examiner in the Office Action, inventions that are related as combination/subcombination are distinct only if it can be shown that the combination as claimed (e.g., claims 26, 28 and 29) does not require the particulars of the subcombination (e.g., claim 1).

In the present application, each of claims 26, 28 and 29 (i.e., the combination claims) include all of the features recited in claim 1 (i.e., the subcombination claim). Accordingly, as the combination claims include all of the features recited in a subcombination claim, Applicants respectfully submit that it is not proper to issue a restriction between such claims based on the guidelines set forth in MPEP 806.05(c)(I).

In view of the foregoing, Applicants respectfully submit that claims 26-30 should be examined on the merits.

II. Claim Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1, 6, 7, 9, 14, 15, 17, 18, 21, 23 and 25 under 35 U.S.C. §103(a) as being unpatentable over Shimada et al. (U.S. 6,504,705) in view of Tadanobu (U.S. 2003/0039093).

Applicants submit that this rejection is improper because the Tadanobu reference is not considered prior art against the present application based on 35 U.S.C. § 103(c). Applicants note that 35 U.S.C. § 103(c) provides that:

“subject matter developed by another person which qualifies as prior art only under one or more subsections (e), (f) and (g) of §102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person”(See MPEP 706.02(l)(1)).

Accordingly, this provision, which became effective November 29, 1999 for all applications filed after that date, precludes a commonly assigned patent from being prior art under §102(e)/103.

As explained in the response filed on June 7, 2005, the Tadanobu reference (US 2003/0039093) published on February 27, 2003, which is after the application's priority date of December 27, 2002. Further, Applicants note that a verified English translation of Applicants' priority document was submitted with the response filed on June 7, 2005, thereby perfecting the priority date of December 27, 2002. Accordingly, due to the submission of the verified English

translation of the priority document, the Tadanobu reference (US 2003/0039093) can only qualify as prior art under §102(e)/103.

Applicants submit that the present application and the Tadanobu reference (U.S. 2003/003903), were, at the time the invention of the present application was made, commonly owned by Matsushita Electric Industrial Co., Ltd.

In view of the foregoing, Applicants submit that the Tadanobu reference (U.S. 2003/003903) cannot be used in a rejection under 35 U.S.C. 103(a) based on the above-noted provision of 35 U.S.C. § 103(c).

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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